

REMARKS/ARGUMENTS

Claims 1-38 are pending in this application. Claims 1-10, 12-21, 23-32, and 34-38 stand substantively rejected. Claims 11, 22, and 33 are objected to as depending from rejected base claims, but are considered to present patentable subject matter. Reconsideration of the rejected claims is respectfully requested. This Amendment adds new claims 39-41.

New Claims

Support for new claims 39-41 can be found in the specification at, for example, page 9, lines 15-16 and page 10, lines 1-2. No new matter is introduced.

First rejection Under 35 U.S.C. §103

Claims 1-10, 12-15, 18-21, 23-30, 32, 34, and 38 were rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent No. 5,938,890 to Schlinkmann et al. ["Schlinkmann"] in view of U.S. Patent No. 4,822,442 to Ashcraft et al. ["Ashcraft"]. This rejection is traversed.

According to MPEP §2143, a *prima facie* case requires, among other things, that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the artisan, to combine the references. Further, the references when combined must teach or suggest all of the claim elements. The proposed combination of Schlinkmann and Ashcraft does not meet these requirements.

Independent Claim 1

Presently pending independent claim 1 is drawn to a component transfer device that includes, a roller device for moving a liner, a gripper for gripping the liner, and a placement actuator for engaging a component and placing it on a target. The gripper and placement actuator are removably coupled with a coupler that can move the placement actuator when the roller device moves the liner.

Neither Schlinkman nor Ashcraft suggest removable coupling

As discussed previously and acknowledged by the Office Action at page 2, Schlinkman does not teach or suggest the presently claimed coupler, wherein the coupler removably couples the gripper and the placement actuator. The Action alleges that Ashcraft's

vacuum chuck (34) and transport (48) read on the presently claimed placement actuator and coupler, respectively. Yet there has been no showing that Ashcraft's transport (48) provides a *removable coupling* between the vacuum chuck (48) and a gripper, and thus Ashcraft fails to remedy the deficiency of Schlinkmann.

No Motivation to Combine Schlinkmann and Ashcraft

As noted above, a *prima facie* case of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the artisan, to combine the references. The proposed rationale for employing Ashcraft's transport (48) in the method and apparatus of Schlinkmann is stated in the Office Action at page 3, and is reproduced below in its entirety.

"[I]n order to facilitate the handling of the materials."

This analysis is conclusory. No guidance is given as to how the cited references, or the knowledge generally available to the artisan, would suggest the desirability of the presently pending claim. There is no showing that the skilled worker would be motivated to modify or replace any particular element described in Schlinkman with Ashcraft's transport (48). The Examiner has a duty to explain why the combination of references is proper. The simple conclusory statement offered in the Office Action is insufficient to meet this duty.

Applicants respectfully submit that in fact, the artisan would not be motivated to combine Schlinkmann and Ashcraft. Schlinkmann reports that lateral movement of the peeler plate (6) and tape drive support assembly (9) relative to the chuck (13) operates to peel the component (21) from the web tape (26). Thus, Schlinkmann already describes a technique for removing an object from a web. Absent a showing to the contrary, Applicants submit there is no reason to combine the reference with Ashcraft. Moreover, if Ashcraft's laterally moveable transport (48) and chuck (34) *were* combined with Schlinkmann's laterally moveable plate (6) and tape drive (9), the resulting combination would require even more complex controls to orchestrate movement of these features. The proposed combination therefore violates the requirements of MPEP §2143.01(V and VI), because it renders Schlinkmann unsatisfactory for

its intended purpose, and also changes Schlinkmann's principle of operation. For at least these reasons, there is no motivation to combine references.

Independent Claim 23

Presently pending independent claim 23 is drawn to a component transfer device that includes, a placement device that engages a component while the component is adhered to a liner, and a gripper that grips the liner. The gripper and placement device are adapted for moving about a same linear distance when the liner is moved. Advantageously, such a configuration allows movement of the gripper and the placement device while the liner moves.

Neither Schlinkman nor Ashcraft suggest gripper and liner movement

Schlinkmann's chuck (13) and brake (12) are limited to perpendicular movement relative to tape (26) movement. There is no teaching that the chuck (13) and brake (12) move about a same linear distance when the tape (26) is moved. In fact, the brake (12) is described as preventing movement of the tape (26). Thus, Schlinkmann fails to teach all elements of presently pending claim 23.

As Applicant's understand it, the Action alleges that Ashcraft's vacuum chuck (34) reads on the presently claimed placement device. Yet there has been no showing that Ashcraft teaches or suggests a gripper adapted for moving about a same linear distance with the placement device when the liner is moved. Thus, Ashcraft fails to remedy the deficiency of Schlinkmann.

No Motivation to Combine Schlinkmann and Ashcraft

As noted above with respect to independent claim 1, the Office Action does not properly establish why the artisan would be motivated to combine Schlinkmann and Ashcraft, and in fact the references themselves teach away from the proposed combination.

Independent Claim 27

Presently pending independent claim 27 is drawn to a method of transferring components from a liner to a desired target. The method includes engaging the liner with a gripper and with a placement actuator, and moving the liner such that the gripper and the placement actuator move with the liner.

Neither Schlinkman nor Ashcraft suggest gripper and liner movement

Schlinkmann describes movement of chuck (13) and brake (12) only perpendicular to movement of tape (26). There is no teaching or suggestion that chuck (13) and brake (12) move with the tape (26). The brake (12) is described as preventing movement of the tape (26). Thus, Schlinkmann fails to teach all elements of presently pending claim 27.

As noted above with respect to independent claim 23, there has been no showing that Ashcraft teaches or suggests a gripper moving with a liner. Thus, Ashcraft fails to remedy the deficiency of Schlinkmann.

No Motivation to Combine Schlinkmann and Ashcraft

As noted above with respect to independent claim 1, the Office Action does not properly establish why the artisan would be motivated to combine Schlinkmann and Ashcraft, and in fact the references themselves teach away from the proposed combination.

Therefore, the proposed combination of Schlinkmann and Ashcraft does not teach or suggest all elements of the presently pending independent claims. Moreover, the Office Action has not elucidated why the artisan would be motivated to implement Ashcraft's transport (48) in the method and apparatus of Schlinkmann. Still further, the Schlinkmann and Ashcraft references themselves teach away from the proposed combination. Accordingly, a *prima facie* case of obviousness has not been established. Claims 2-10, 12-15, and 18-21 depend directly or indirectly from claim 1, claims 24-26 depend directly from claim 23, and claims 28-30, 32, 34, and 38 depend directly from claim 27. Thus, these claims are also allowable as depending from allowable base claims, as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

Second Rejection Under 35 U.S.C. §103

Claim 16 was rejected under 35 U.S.C. §103(a) as allegedly obvious over Schlinkmann in view of Ashcraft as applied to claim 1 above, and further in view of U.S. Patent No. 6,009,926 to Viktorius et al. ["Viktorius"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim

elements. Further, there must be motivation to combine the references. The proposed combination of Schlinkmann, Ashcraft, and Viktorius does not meet these requirements.

As noted above, the proposed combination of Schlinkmann and Ashcraft do not teach or suggest the presently claimed coupler, wherein the coupler removably couples the gripper and the placement actuator. Viktorius discusses a device for attaching adhesive labels to packaged goods, but fails to teach or suggest a device having a gripper and a placement actuator that are removably coupled with a coupler. Moreover, the Office Action has provided no guidance as to why the artisan would be motivated to implement Ashcraft's transport (48) in the method and apparatus of Schlinkmann. Still further, the Schlinkmann and Ashcraft references themselves teach away from the proposed combination. For at least these reasons, Viktorius fails to remedy the deficiencies of Schlinkmann and Ashcraft. Presently pending claim 16 depends directly from claim 1, and is therefore allowable as depending from an allowable base claim as well as for the nonobvious combination of elements it recites. Withdrawal of this rejection is respectfully requested.

Third Rejection Under 35 U.S.C. §103

Claim 17, and claims 31 and 35-37, were rejected under 35 U.S.C. §103(a) as allegedly obvious over Schlinkmann in view of Ashcraft, as applied to claims 1 and 27 above, respectively, and further in view of U.S. Patent No. 6,368,446 to McNestry et al. ["McNestry"]. This rejection is traversed.

According to MPEP 2143, a *prima facie* case of obviousness requires, among other things, that the cited references when combined must teach or suggest all of the claim elements. Further, there must be motivation to combine the references. The proposed combination of Schlinkmann, Ashcraft, and McNestry does not meet these requirements.

As noted above, the proposed combination of Schlinkmann and Ashcraft do not teach or suggest a device having a gripper and a placement actuator that are removably coupled with a coupler, nor do they teach or suggest a method of transferring components from a liner to a target wherein a gripper and a placement actuator move with a liner as presently claimed. McNestry discusses a device for attaching labels to articles, but fails to teach or suggest the elements that are missing from Schlinkmann and Ashcraft. Moreover, the Office Action has

provided no guidance as to why the artisan would be motivated to implement Ashcraft's transport (48) in the method and apparatus of Schlunkmann. Still further, the Schlunkmann and Ashcraft references themselves teach away from the proposed combination. For at least these reasons, McNestry fails to remedy the deficiencies of Schlunkmann and Ashcraft. Presently pending claim 17 depends directly from claim 1, and presently pending claims 35-37 depend from claim 27, and thus these claims are allowable as depending from allowable base claims as well as for the nonobvious combination of elements they recite. Withdrawal of this rejection is respectfully requested.

Patentability of New Claims 39-41

In general, new claims 39-41 are drawn to devices and methods wherein the gripper and the placement actuator move a linear distance in response to movement of the liner. As noted in the specification at page 10, lines 3-11, this can prevent the liner and component from being compressed, bunched, or otherwise deformed, help retain tension in the liner, and also reduce the potential for slippage, thus resulting in the accurate retention and placement of the component. Schlunkmann does not teach or suggest that a gripper and placement actuator can move a linear distance in response to movement of a liner. Ashcraft describes a vacuum chuck (34), but not a gripper. Moreover, Ashcraft reports that transport (48) causes movement of gear rack (54) which causes movement of idler gear (5) which in turn causes movement of web drive roll (72) which pulls web (14). Ashcraft fails to teach or suggest the opposite situation, where for example movement of the liner causes movement of a placement actuator, or movement of a gripper.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

/Nathan S. Cassell/

Nathan S. Cassell
Reg. No. 42,396

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
60844628 v1